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IN THE

Supreme Court of the United States

OCTOBER TERM, 1934.

No. 255. 256

ALTOONA PUBLIX THEATRES, INC.,
Petitioner,

and

WILMER & VINCENT CORPORATION and LOCUST STREET REAL ESTATE COMPANY,
Petitioners,

vs.

AMERICAN TRI-ERGON CORPORATION and TRI-ERGON HOLDING, A. G.,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT.

BRIEF FOR RESPONDENTS IN OPPOSITION.

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INDEX.

	PAGE
Opinions Below	1
Jurisdiction	2
Question Presented	2
Statement	2
Argument	7
The Decision Below is not in Conflict with Decisions of this Court on the Question of Invention	7
The Decision Below is not in Conflict with the Decisions of this Court in *Railway Co.* v. *Sayles*, 97 U. S. 554, and *Pattee Plow Co.* v. *Kingman*, 129 U. S. 294, Claims 9, 13, 17, 18 and 19, Finding Ample Support in the Disclosure of the Original Application	14
The Decision Below is not in Conflict with the Decisions of this Court with Respect to what is a Patentable Process	16
The Decision Below is not in Conflict with the Decision of the Court of Appeals of the Sixth Circuit in *Fruehauf Trailer Co.* v. *Highway Trailer Co.*, 67 F. (2d) 558	18
There is no Uncertainty in the Rule of Law to be Applied under R. S. 4887 in Determining whether there has been a Forfeiture of a Patent, and the Rule of Identity of Claims was Correctly applied in the Courts Below	22
Conclusion	23
Appendix	24
Claims relied on, as Granted, with Disclaimer Applied	24

CASES CITED.

PAGES

Abercrombie & Fitch Co. v. Baldwin, 245 U. S. 198, 206-207 16
American Road Machine Co. v. Pennock & Sharp Co., 164 U. S. 26, 41 ..... 10, 11, 12

Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403 ..... 17, 19, 20
Cohens v. Virginia, 6 Wheat. 264, 399 21
Concrete Appliances Co., et al., v. Gomery, et al., 269 U. S. 177, 180 ..... 7, 10, 13

DeForest Radio Co. v. General Electric Co., 283 U. S. 664, 678, 682 ..... 10, 13, 14
Diamond Rubber Co. v. Consolidated, 220 U. S. 428 13

Eibel Process Co. v. Minnesota & Ontario Paper Co., 261 U. S. 45, 64 12
Expanded Metal Co. v. Bradford, 214 U. S. 366 17

Fireball Gas Tank & Ill. Co. v. Commercial Acetylene Co., 239 U. S. 156 22
Fruehauf Trailer Co. v. Highway Trailer Co., 54 F. (2d) 691, 67 F. (2d) 558 ..... 18, 20, 21

General Electric Co. v. Cooper Hewitt Elec. Co., 249 F. 61; Certiorari denied, 246 U. S. 668 16
Grinnell Washing Machine Co. v. Johnson Co., 247 U. S. 426, 432 ..... 10, 12, 13

Hailes v. Albany Stove Co., 123 U. S. 582, 587 ..... 18, 20, 21
Hailes v. Van Wormer, 87 U. S. 353 ..... 10, 12
Heller Bros. v. Crucible Co., 297 F. 39 16
Hobbs v. Beach, 180 U. S. 383, 391, 392, 395-397 ..... 13, 15
Holland Furniture Co. v. Perkins Glue Co., 277 U. S. 245, 253 ..... 16, 18
Home Bldg. & Loan Assoc. v. Blaisdell, 290 U. S. 398, 434 21
Hurlbut v. Schillinger, 130 U. S. 456, 463 20

PAGES

Leeds & Catlin Co. v. Victor Talking Machine Co., 213 U. S. 301, 322, 323 ..... 17, 22

Palmer v. Corning, 156 U. S. 342, 345 10
Pattee Plow Co. v. Kingman, 129 U. S. 294 ..... 14, 16
Powers-Kennedy Contracting Corp., et al., v. Concrete Mixing & Conveying Co., 282 U. S. 175 ..... 10, 13

Railway Co. v. Sayles, 97 U. S. 554 ..... 14, 15
Risdon Locomotive Works v. Medart, 158 U. S. 68 ..... 16, 18
Robertson v. Blake, 94 U. S. 728 12
Rockwood v. General Fire Extinguisher Co., 8 F. (2d) 682; Certiorari denied, 269 U. S. 571 12

Siemens v. Sellers, 123 U. S. 276 22
Sterling v. Constantin, 287 U. S. 378, 400 21
Straus v. Crane, 235 F. 126 19

Telephone Cases, 126 U. S. 1 17
Texas & N. O. R. Co. v. Brotherhood Ry., etc., 281 U. S. 548 7
Thomson Spot Welder Co. v. Ford Motor Co., 265 U. S. 445 7
Tyson & Bros. v. Banton, 273 U. S. 418, 432 21

Weaver v. Palmer Bros., 270 U. S. 402, 414 21
Westinghouse v. Boyden Power Brake Co., 170 U. S. 537 ..... 16, 17, 18

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OPINIONS BELOW.

The District Court's opinion appearing in Vol. II of the Record at page 1027, is reported in 5 Fed. Supp. 32. The opinion of the Circuit Court of Appeals appearing in

Vol. II of the Record, page 1157, is not officially reported. Both opinions have been separately printed by the Petitioners for the convenience of the court. The Circuit Court of Appeals also rendered a supplemental opinion on August 6, 1934 not officially reported but filed in this court after the filing of the record.

JURISDICTION.

The jurisdiction of this Court is invoked under Sec. 240a, Judicial Code, as amended by the Act of February 13, 1925, 43 Stat. 938 (Title 28, U. S. C. A., § 347).

QUESTION PRESENTED.

This is an ordinary patent suit for infringement and the sole question presented is whether the patent is valid. Infringement is not contested. The petitioners contend that the patent is invalid for want of invention, because of expansion of the claims beyond the original disclosure, because the process claims are for the mere function of a machine, because of a disclaimer filed before trial and because of forfeiture under R. S., 4887 by reason of an earlier German patent issued to the same inventors.

Respondents dispute all of these contentions, all of which were resolved in their favor in both courts below.

STATEMENT.

The patent in these suits, #1,713,726, was granted on May 21, 1929 (Vol. III, pp. 1-10, and printed in pamphlet form herewith). It relates to photographic sound on film recording and reproducing. It is owned by the American Tri-Ergon Corporation, one of the Respondents. On October 10, 1932, the bills of complaint (Vol. I, pp. 9, 28) were filed against Petitioners, who operate motion picture theatres, charging infringement of said patent. A disclaimer to the patent was filed before trial (Vol. III, p. 227, and Appendix, *infra*, p. 23). Both suits were tried on the

same record and defended by R. C. A. Photophone, Inc. (a wholly owned subsidiary of Radio Corporation of America), the licensor of the infringing machines. Validity was contested but not infringement (Vol. II, p. 1049). The type PS-16 machine, involved in the Altoona Public suit, was held to infringe claims 9, 13, 17, 18 and 19, as charged. The type PS-1 machine, involved in the Wilmer & Vincent suit, was held to infringe claims 5, 7, 9, 13, 18 and 19, as charged (pp. 1049, 1090). No petition for a rehearing was filed.

The Radio Corporation and Western Electric Company are cross-licensors in the sound picture field (Vol. II, pp. 1024-25), and apparently have enjoyed a substantial monopoly in supplying sound picture machines to the industry in this country (Vol. II, pp. 847-51). Western Electric commenced in August, 1926 to put out sound picture machines. These embodied only sound on *disk*. One of the patentees then brought one of their Tri-Ergon sound on *film* machines here in December, 1926, and demonstrated and discussed it with Western Electric engineers, after which Western Electric carried on experiments with sound on *film* (Finding 31, Vol. II, p. 1047). The first R. C. A. sound picture machine of any kind was put out in October, 1928 (Finding 29, Vol. II, p. 1046). Machines put out and licensed by each of these two companies have been equipped for sound on film and sound on disk (Vol. V, pp. 1411-17), but in the last few years sound on film sound pictures have driven sound on disk sound pictures from the market (Finding 24, Vol. II, p. 1045).

The record here contains over 2,900 pages. The trial court heard many witnesses, fact and expert; witnessed extensive demonstrations of Petitioners' and Respondents' machines and of many alleged prior art models, and after an exhaustive review of the record, as shown from the many findings of fact and conclusions of law considered and passed upon (Vol. II, pp. 1037-1129)—it rendered its opinion accompanied by said findings which should be read as a part of the trial court's opinion. They cover all of the

points here presented by Petitioners, and are against them in every particular.

The trial court found, among other things, that the patent in suit discloses apparatus and methods which made possible the successful establishment of a new and important art—sound on film sound pictures (Vol. II, pp. 1030 and 1045); that the invention made possible the first successful photographic sound reproduction (p. 1079); that the patentees were the first in the world to demonstrate publicly sound on film either with or without pictures, which they did in 1922 with a machine made according to the patent (p. 1045); that the prior efforts of various other scientists to produce sound on film were unsuccessful (p. 1084); and no sound on film machine was ever previously put out (pp. 1045-6); that the features of the claims all cooperate to produce *the new and useful result of distortionless sound reproduction from sound on film* (pp. 1078 and 1030); and that none of the seventy odd patents cited, anticipated or invalidated the claims (pp. 1077-78); that the prior art sound on film patents were for inoperative, useless structures (p. 1080); that the old Edison cylinder and disk gramophones with flywheel control, involved entirely different problems and were superseded by centrifugal ball governors useful there, but not satisfactory for and not used in sound on film machines (pp. 1069; 1070-71; 1050); that the claims are not merely for the use of a fly wheel in a sound head (p. 1048)[a]; that the patent is entitled to a

[a]Not only are the claims for combinations of features, but as to the flywheel itself there are many places in a sound on film machine where a flywheel may be placed without operatively controlling the film. By reason of the teachings of the patent it is now known that the flywheel should be associated with the cylinder—sprocket or roller—either at or adjacent the optical slit (translation point) over a portion of which cylinder the film passes so as to properly control the film, and that it should not be associated with some other part of the machine where it will not properly function.

pioneer status (p. 1078), and that all of the claims at issue were valid and infringed (p. 1090).

The Circuit Court of Appeals (who also had the various machines and models before it) in a comprehensive opinion affirmed the trial court in its findings and conclusions, in which it stressed the points that the prior art sound on film patents were inoperative paper patents (p. 1162); that these paper patents embodied many disturbing factors preventing proper photographic sound on film, and that these disturbing factors had never been segregated, diagnosed and then collectively remedied, until the patentees did it (p. 1160); that the suggestions and prophesies found in the prior art were confusing and not helpful (p. 1162); that each of the elements of the patent in suit coacts directly with the others to produce a new and useful result, the prevention of sound distortion (pp. 1162-3). Thus the invention made possible the successful recording and reproduction of sound on film, which had not been attained because of many difficulties in eliminating the different disturbing elements which reacted one upon another. The apparatus designed was the first embodiment of successful invention.

It is not possible to fix a film in a machine as Edison fixed his cylinders. The flimsy light film enters the sound head from the motion picture machine at 90 ft. per minute charged with complex vibrations. Each successive short length of film at the optical slit must be instantaneously and momentarily endowed with the property of a heavy mass and brought into accurate focus with the fine line of light and yet permitted immediately to pass on out of the sound head. Applying the inertia control directly to a film adjacent the translation point had not even occurred to anyone. No one yet knew that irregularities in the film perforations and the meshing of the sprocket teeth therewith would cause distortion of the sound. No one had dis-

covered the sources of the difficulties, although scientists had tried unsuccessfully for years to use light to translate sound to or from film. Prophesies and speculations for remedying one or another of the disturbing factors while retaining others, got nowhere from a practical standpoint because the remaining disturbing effects left the result so poor that the actual effect of the proposed remedy could not be determined.

No one had successfully used film sound records of any kind, nor sound modulated light in any practical art.

The uniformity of speed of the film, the arcuate bending of the film and the focused line of light all coact at the same point to determine the desired spacing, definition and transparency of the light lines photographed for distortionless sound recording—pitch and volume; and in reproducing they all coact at the same point in determining the character of each instantaneous, modulated fine line of light directed upon the P.E. cell to produce distortionless sound reproduction.

Petitioners' assertions as to the facts in this case are contrary to the findings below. Thus for example they seek to build up a case of inconsistency with this Court's opinions by attempting to create the impression that the gist of the invention here was the use of a flywheel in an old well known film phonograph, and by representing that the problem here was the same as in Edison's old cylinder phonograph. The lower courts on the evidence presented have found against them on each of these points and their only references for sound on film are to paper patents which do not anticipate.

There is no reason for granting this petition. This is merely an ordinary patent suit in which Petitioners seek to have this Court review all but one of their defenses below. The questions presented are largely questions of fact upon which both courts below have concurred in finding for the Respondents. The issues relate to the validity

of a patent. There is no conflict among the Circuits on that issue nor any conflict between the decision of the court below and any other court upon any question of law involved, and no novel or unusual questions of law are involved.

Petitioners assert that a brief which it has been sought to file as *amicus curiae,* was tendered "on behalf of substantially the entire motion picture industry". This statement is not supported by the record or by the brief sought to be filed, and many important producers and exhibitors of sound motion pictures did not join in the petition for leave to file the brief (Vol. II, pp. 848-51).

So far as concerns the effect of this patent on the industry, the record further shows that up to a few years ago, disk-sound pictures were in commercial use until driven from the market by the superiority of the invention here involved. The industry is free to go back to that apparatus which this record further shows the infringing machines are equipped to use (Vol. V, pp. 1411-17).

ARGUMENT.

THE DECISION BELOW IS NOT IN CONFLICT WITH DECISIONS OF THIS COURT ON THE QUESTION OF INVENTION.

The question of patentable invention is a question of fact. *Thomson Spot Welder Co.* v. *Ford Motor Co.,* 265 U. S. 445; *Concrete Appliances Co.* v. *Gomery,* 269 U. S. 177, 180. Both courts below decided this question against the petitioners. Under the well-established rule this Court accepts the findings in which two courts concur unless clear error is shown, *Texas & N. O. R. Co.* v. *Brotherhood Ry. &c.,* 281 U. S. 548, or, in patent cases, unless the question of fact has been differently decided in two circuits. *Thomson Spot Welder* v. *Ford Motor Co.,* supra; *Concrete Appliances Co.* v. *Gomery,* supra.

The claims in suit were sustained in the District Court upon extensive findings of fact predicated upon evi-

dence much of which was conflicting and contradictory. The Circuit Court of Appeals found no error justifying reversal of the trial court's findings or conclusions, and upon a careful review of the record stated its own conclusions upon the facts and the law, which are in accord with those of the trial court. Upon the facts thus found the decision of the court below is in accord with the decisions of this Court upon the question of invention.

After describing the invention in its relation to the art, the Court of Appeals reached the following conclusions:

> "The prior art does not disclose this combination nor the result which it produced. The evidence shows that the moving, talking picture art was looking for something like this. The defendants point to some seventy patents, some having one element of the patent in issue, and some another, but none have this combination and none produce the result of this combination. The patentees were the first to accomplish successfully and commercially photographic sound on film reproduction. The suggestions and prophecies found in paper patents were confusing and not helpful.
>
> "This new combination of the patent was not obvious to one skilled in the art for no one else had discovered it, although many were working on it and it required years of patient study and research before the patentees were able to work out this combination and method, although some of the individual elements were old, one being found here and another there in inoperative paper patents. The defendants were unable to produce a single anticipation among the seventy or more paper patents upon which they relied.
>
> "The trial judge said that the combination and methods of the claims of the patent in issue are not found in any prior art citations and are new and useful. A close study of the citations confirms this finding. No one before the patentees was able to bring together

> all the elements of the patent into a successfully operative combination. Each of these elements coact directly with the others to produce a new and useful result, the prevention of sound distortion. It is well settled that a new combination, every element of which is old, is patentable if it produces a new and useful result, or an old result in a 'new and materially better way', or an 'old result in a more advantageous way' " (Vol. II, pp. 1162, 1163).

Referring to the many difficulties which confronted the art, and which were overcome by the inventors, the Court said:

> "These had never been segregated and diagnosed and then collectively remedied, until the patentees did it" (Vol. II, p. 1160).

The trial court expressly found that the claims are not merely for the use of a fly wheel in a sound head, and that the combination and methods of the claims in suit are not found in any of the prior art citations and are new and useful (Vol. II, pp. 1048; 1078).[1]

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[1]For the facts in detail see findings of the trial court (Vol. II, pp. 1037-1090). The Pedersen patent is covered by Finding 71 (Vol. II, p. 1077), Finding 54 (Vol. II, p. 1056) and Conclusion of Law 9 (Vol. II, p. 1080). The Ries Patent is covered by Finding 59 (Vol. II, p. 1068) and Conclusion of Law 9 (Vol. II, p. 1080). The Edison cylinder phonograph equipped with a fly wheel is covered in Findings 60 and 62 (Vol. II, pp. 1069-71), and the Dragoumis Patent by Finding 56 (Vol. II, p. 1062). As to petitioners' assertion that only the use of a fly wheel performing its well known function is embodied in the claims, see Findings describing the combination of the patent numbered 1 to 17; 23-a to 26, and 73 (Vol. II, pp. 1037-42, 1045-46, 1078) and particularly Findings 32, 37, 38 and 39 (Vol. II, pp. 1048-51); and also Conclusions of Law 2 and 4 (Vol. II, pp. 1078-9).

Upon the facts found by both courts below the patented combination clearly involved invention under rules repeatedly enunciated by this Court. *Hailes* v. *Van Wormer*, 87 U. S. 353; *Palmer* v. *Corning*, 156 U. S. 342, 345; *Grinnell Washing Machine Co.* v. *Johnson Co.*, 247 U. S. 426, 432.

The lower court cited these very cases (now relied upon by petitioners) for the rule it followed. It recognized the rule but also that the invention before it was distinctly different from the stove in the *Hailes* case, each of the separate elements of which had been well known and in public use in stoves; from the sewer grate of the *Palmer* case as to which the Court said: "A grate over a sewer is one of the simplest of mechanical devices"; and from the washing machine which was merely the gearing together of a common washing machine and a common wringer with a control handle.

Thus the court below recognized and applied to the particular facts peculiar to this case the "settled" rule enunciated by this Court governing the patentability of new and useful combinations of old elements producing either a new result or an old result in a better way. There was no misstatement of the established rule, and therefore no conflict of decisions. Furthermore, the established principles were correctly applied.

The decision of the court below is not in conflict with any of the following decisions of this court which are relied upon by the petitioners as conflicting:

American Road Machine Co. v. *Pennock & Sharp Co.*, 164 U. S. 26.

Grinnell Washing Machine Co. v. *Johnson Co.*, 247 U. S. 426.

Concrete Appliances Co., et al., v. *Gomery, et al.*, 269 U. S. 177.

Powers-Kennedy Contracting Corp., et al., v. *Concrete Mixing & Conveying Co.*, 282 U. S. 175.

DeForest Radio Co. v. *General Electric Co.*, 283 U. S. 664.

In *American Road Machine Co.* v. *Pennock, et al., supra,* a patent for a machine for making, repairing and cleaning roads was held void for want of invention. The claim of invention was predicated upon increasing the weight of the old well known hand-wheel for lifting the road scraper employed in this class of machinery. The opinion, as we understand it, goes no further than to hold that road machine mechanisms had been operated by hand-wheels; that such mechanism was a "common device" and had been used in various machines, and a heavy wheel in *"this class of machinery"* to secure "the well known result", was not patentable. After an exhaustive review of the prior art this Court concluded (164 U. S., p. 41).

> "But the decision of the Circuit Court rested on the want of invention, and in that conclusion we concur.
>
> "'The whole essence of the Taft invention', says appellant's counsel, is the application of momentum to carry the wheel along 'sufficiently to enable the operator to take a new grasp (as explained by Mr. Breevort), without clamping the wheel to prevent its running backward'.
>
> "Did increasing the weight of the hand-wheels *in this class of road machines,* in order to correct the tendency of smaller wheels to reverse, involve patentable novelty?
>
> "We do not think so. The use of hand-wheels as a substitute for straight levers *in this class of machinery* was old, and whether the wheels were light or heavy (and heavy wheels were old), they alike performed the service of rotary levers." (Italics ours.)

Obviously there is no conflict between that decision and the decision of the court below, unless, as petitioners seem to contend, no use of a flywheel in any combination for any purpose can be patentable, no matter what the character of the machine embodying it, or the arrangement,

purpose or result may be. Of course this is not the law, and the *Road Machine* case did not so hold.

In *Robertson* v. *Blake*, 94 U. S. 728, the patentable machine was certainly not the first commercially successful stone crusher. It could not be compared in its relation to the art with the apparatus disclosed by the patent in suit. And yet in that case this Court found the use of a flywheel in combination with a revolving shaft and a movable jaw to be patentable invention. Even a novel application of the force of gravity may involve invention. *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U. S. 45, 64; *Rockwood* v. *General Fire Extinguisher Co.*, 8 F. (2) 682 (C. C. A. 2); (Certiorari denied, 269 U. S. 571).

Grinnell Washing Machine Co. v. *Johnson Co.*, 274 U. S. 426, was cited and relied upon in the court below in holding upon the facts found that a combination of the claims was a patentable invention. In that case this court restated the rules, which it declared were authoritatively settled by its own decisions for determining the patentability of combinations of old elements known to the art. The opinion of the Court states (p. 432):

> "Generally speaking, a combination of old elements in order to be patentable must produce by their joint action a novel and useful result, or an old result in a more advantageous way."

It then quotes from *Hailes* v. *Van Wormer, supra:*

> " 'It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made. But the results must be a product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements'. * * *

'Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention' " (p. 432).

The applicable and controlling principles in the *Washing Machine* case were properly applied to the facts found in the court below and the case was cited as authority for the application of the rule. (Opinion below, Vol. II, p. 1163.)

Other decisions of this Court sustaining the patentability of combinations of old elements are *Hobbs* v. *Beach*, 180 U. S. 383, 391-392, cited by the trial court and *Diamond Rubber Co.* v. *Consolidated*, 220 U. S. 428.

In *Concrete Appliances Co.* v. *Gomery*, 269 U. S. 177, the question of invention was stated to be one of fact dependent upon consideration of the state of the art as applied to the disclosure of the patent in that suit (p. 180). No rule different from that of the *Washing Machine* case was stated. The old rule was simply applied to the particular device before the Court.

Powers-Kennedy Contracting Corp., et al., v. *Concrete Mixing & Conveying Co.*, 282 U. S. 175, was simply the application of the same rule to another state of facts.

In *DeForest Radio Co.* v. *General Electric Co.*, 283 U. S. 664, Langmuir's patent for a high vacuum discharge tube used as a detector and as an amplifier in radio communication and telephony, and for the process of making it, was held invalid both for want of invention and because of prior use. No new rule was stated. The Court simply affirmed the findings of the trial court—that on the evidence presented the Langmuir improvement was an obvious thing and in prior use (pp. 682, 685).

This Court was careful to point out in its opinion (p. 678) that even though the improvement was accomplished by a change so simple as to be brought about by reducing the pressure in the well-known low vacuum tube by a few

microns, still it might be invention. But the trial court having found that both the method and the result of such a change were well known to the art (p. 682), this Court concluded that the patent was void for want of invention.

Here the invention and its relation to the prior art are entirely different from those in Petitioners' cases; and the courts below simply applied the settled rule of this Court to a different state of facts.

THE DECISION BELOW IS NOT IN CONFLICT WITH THE DECISIONS OF THIS COURT IN *RAILWAY CO.* v. *SAYLES*, 97 U. S. 554, AND *PATTEE PLOW CO.* v. *KINGMAN*, 129 U. S. 294, CLAIMS 9, 13, 17, 18 AND 19, FINDING AMPLE SUPPORT IN THE DISCLOSURE OF THE ORIGINAL APPLICATION.

This, of course, is a question of fact. And here, again, the findings below in both courts were against the petitioners.

Petitioners contend in substance that in the original application it was not indicated that the following features were part of the invention, i. e., (1) arcuate bending of the film; (2) the use of a film feeding sprocket in addition to the cylinder over which the film is passed; (3) the photo electric cell; and (4) the optical slit. But the trial court found as a fact that each of these four features was disclosed in the original application as filed.[2] As to all of these features the trial court found that "The combinations and methods of the claims in suit were adequately disclosed under the provisions of R. S., 4888, in the application for the patent in suit as originally filed" (Vol. II, p. 1080).

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[2]As to features (1), (3) and (4), see Finding 6 (Vol. II, pp. 1038, 1039), and as to feature (2) see Finding 14 as to Figure 2 originally in the application disclosing this feature (Vol. II, p. 1041), also described in the original specification, see Appendix to Petitioners' Brief, p. 43, and in Finding 72 (Vol. II, p. 1077).

It is significant that petitioners have omitted as a part of the original specifications printed in the appendix to their brief all of the original drawings which form an important part of the disclosure. They are found with the patent (Vol. III, pp. 1-10, and printed in pamphlet form herewith).

The petitioners also claim that it was not until after the Radio Corporation of America had put out their machines that these four features were included in some of the claims, and that such inclusion was an expansion of the invention to cover the machines which have been held to infringe in the courts below. The record, however, fails to show that any machine was put out by Radio Corporation prior to the grant of the patent (May, 1929) excepting only a single isolated PS-1 machine, in October, 1928, at Johnstown, Pennsylvania, and that no PS-16 machine was put out until several months after the grant of the patent (Vol. II, p. 848, and Finding 29, p. 1046). The PS-1 machine was held to infringe Claims 5, 7, 9, 13, 18 and the PS-16 machine was held to infringe Claims 9, 13, 17, 18 and 19 (Vol. II, p. 1090). Claims 5, 7 and 9 were made long prior to the date of the earlier machine (the first two in March, 1925, and the last in May, 1928; Vol. III, pp. 52-3, 79). Thus each of these machines infringed at least one of the patent claims already in the application before the machine was built.

The claims being fully supported by the disclosure of the original application, and no intervening rights having accrued, the decision below was controlled by *Hobbs* v. *Beach,* 180 U. S. 383, 395-397, where these considerations were emphasized and made the basis of decision in distinguishing from *Railway Co.* v. *Sayles,* 97 U. S. 554. In that case (pp. 557-59) the original application, rejected as defective and insufficient, lay dormant and unaltered for five years during which time defendants' machines were put out, whereupon a new application was filed with new drawings and specifications disclosing a new apparatus,

different from the original in construction and operation. Even when implication from the drawings and specifications of the original application is necessary to support the new claims, this Court will sustain such claims provided they have not been expanded beyond what may reasonably be implied from the original disclosure. *Abercrombie & Fitch Co.* v. *Baldwin*. 245 U. S. 198, 206-207.

Pattee Plow Co. v. *Kingman*, 129 U. S. 294, involved a reissue patent filed over two years after the application for the original patent, and this Court found that the reissue claim sued on was broader than the original claim and held the patent invalid on that ground, under the well established rule that a patent cannot be broadened by a reissue after two years in the absence of special circumstances excusing the delay. The decision is not applicable in the case at bar.

That the court below clearly understood the rules established by this Court on this point is shown not only by the opinion in this case but by its earlier opinion in *Heller Bros.* v. *Crucible Co.*, 297 Fed. 39, where the law was reviewed at length. Certiorari was denied on this point in the case of *General Electric Co.* v. *Cooper-Hewitt Electric Co.*, 249 Fed. 61 (Certiorari denied, 246 U. S. 668).

THE DECISION BELOW IS NOT IN CONFLICT WITH THE DECISIONS OF THIS COURT WITH RESPECT TO WHAT IS A PATENTABLE PROCESS.

Both courts below having found the method claims to be valid, petitioners assert that the decision below is in conflict with the decisions of this Court in *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U. S. 245; *Westinghouse* v. *Boyden Power Brake Co.*, 170 U. S. 537, and *Risdon Locomotive Works* v. *Medart*, 158 U. S. 68. These cases are not applicable.

When *Risdon Locomotive Works* v. *Medart, supra*, was decided it was assumed that a patentable process must

involve a chemical or other similar elemental action. This assumption was questioned by this Court in *Westinghouse* v. *Boyden,* 170 U. S. 537, and until its decision in *Expanded Metal Co.* v. *Bradford,* 214 U. S. 366, the question as to whether any process involving a purely mechanical operation was patentable was not entirely free from doubt. But in the latter case the Court, after reviewing all of the decisions of this Court upon the subject, including the *Telephone Cases,* 126 U. S. 1; *Carnegie Steel Co.* v. *Cambria Iron Co.,* 185 U. S. 403, and *Leeds & Catlin Co.* v. *Victor Talking Machine Co.,* 213 U. S. 301,[8] concluded:

> "That an invention or discovery of a process or method involving mechanical operations, and producing a new and useful result, may be within the protection of the Federal statute, and entitle an inventor to a patent for his discovery" (214 U. S., at 386).

This Court also pointed out in the *Expanded Metal* Case (p. 386) that in the *Telephone* Cases it had sustained a patent for a method of transmitting electrical undulations similar in form to the vibrations of the air accompanying vocal sounds, and at the same time the patent for the apparatus by which the method was operated was sustained; and that in the *Leeds & Catlin* Case it had held that a process and apparatus by which it is performed are distinct things, and may be patented in one patent or in different patents.

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[8]The process claim involved in the *Victor Talking Machine* case read as follows:

> "Claim 5: The method of reproducing sounds from a record of the same, which consists in vibrating a stylus, and propelling the same along the record by and in accordance with the said record, substantially as described" (213 U. S., at 314).

Compare with process claims 9, 18 and 19 (appendix, infra).

Upon the findings of the courts below the method claims here in suit are clearly within the decision of this Court in the last four cases, and the decisions of this Court relied upon by the petitioners are not applicable,—*Risdon Locomotive Works* v. *Medart, supra,* because the ruling of that case has been limited and qualified by the later decisions of this Court; *Westinghouse* v. *Boyden, supra,* because the only question there presented was whether the *apparatus* claims were drawn on the function of the apparatus rather than upon its structure, the opinion stating that the case did not call for any expression of opinion on what may be a patentable process; *Holland Furniture Co.* v. *Perkins Glue Co., supra,* because that decision dealt solely with a product claim for vegetable glue, and the opinion expressly states that the "process claims are not before us" (p. 253).

THE DECISION BELOW IS NOT IN CONFLICT WITH THE DECISION OF THE COURT OF APPEALS OF THE SIXTH CIRCUIT IN *FRUEHAUF TRAILER CO.* v. *HIGHWAY TRAILER CO.*, 67 F. (2d) 558.

The petitioners assert a conflict between the decision of the court below sustaining the validity of a disclaimer and the decision in *Fruehauf Trailer Co.* v. *Highway Trailer Co.*, 67 F. (2d) 558 (C. C. A. 6th), declaring a disclaimer invalid. In that case the disclaimer was obviously invalid under the ruling of this Court in *Hailes* v. *Albany Stove Co.*, 123 U. S. 582, but there is no conflict here with the latter decision and none is asserted by the petitioners.

The trial court in its Opinion held:

> "The disclaimer limits the patent and does not enlarge it. The subject matter of the disclaimer is consistent and in accordance with the teachings of the patent. No part of the disclaimer broadens or purports to broaden the scope of the claim of the patent. The presumption of validity of the patent in suit is

> unaffected by the disclaimer and the claims in suit here, as modified by the disclaimer, are valid. Carnegie Steel case, 185 U. S., at 435" (Vol. II, p. 1034).[4]

The court below considered this defense, regarded it as unsubstantial, and affirmed the decision of the trial court (Vol. II, p. 1172).

The facts relating to the disclaimer are: (1) No claim is broadened by the disclaimer (pp. 1086-7); (2) each of the features by which the claims in suit are qualified by disclaimer was shown and described in the application for the patent as filed and in the patent as granted (pp. 1077 and 1041); (3) each of the limitations by disclaimer was actually included in one or more of the claims of the patent as issued (p. 1086); (4) each limitation is entirely consistent and in accordance with the teachings of the patent (p. 1086); (5) the disclaimer qualifies the already claimed apparatus or method by limiting it to one wherein the sound is translated by light to or from the film (p. 1086); (6) the disclaimer qualifies claims 9, 13, 18 and 19, by limiting them to the feature of flywheel control, a feature disclosed in the specification and covered in several of the claims as issued (p. 1086); (7) the disclaimer qualifies claim 17 by limiting it to a sprocket forming a part of the "carrier-progressing means" (already in the claim) located with respect to a portion of the periphery of the "cylinder" already in the claim. This construction is in accordance with the teachings of the patent, which disclose the arrangement, for example, in connection with Figure 2 (pp. 1086 and 1041).

Upon this state of facts the disclaimer was valid under the decision of this Court in *Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403. In *Straus* v. *Crane*, 235 Fed. 126 (C. C. A. 2nd), Judge Learned Hand stated (p. 129): "We

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[4]See also Finding No. 72, Vol. II, page 1077, and Conclusion No. 24, Vol. II, page 1086.

do not mean to suggest that a disclaimer may not add a new element to the combination, thereby limiting it to a part only of what was covered by the specifications. That was the effect of the disclaimer in *Carnegie Steel Co.* v. *Cambria Iron Works,* 185 U. S. 403." The disclaimer sustained by this Court in *Hurlbut* v. *Schillinger,* 130 U. S. 456, had the same effect of limiting the claim to a part only of what was covered by the specifications. In that case the limitation was accomplished by adding a new element to the combination, i. e., the tar paper or other material between the blocks of concrete (see p. 463).

There was no attempt in the case at bar by merely filing a paper to make a new patent, or one for a different invention from that shown and described in the specification and drawings of the patent. That is what was attempted in *Hailes* v. *Albany Stove Co.,* 123 U. S. 582, as the Court stated at page 587. In that case it was also held:

> "The first claim, as modified by the disclaimer, has nothing in the specification to stand upon, nothing to explain it, nothing to furnish a reason for it."

Fruehauf Trailer Co. v. *Highway Trailer Co.,* 67 F. (2d) 558 (C. C. A. 6th), involved a set of facts similar to those in the *Hailes* case, and the Court held that the disclaimer did not limit the combination already claimed but expanded it to cover structures upon which it could not before have been read; and in effect claimed a new and a different combination by the addition of a structural feature which was not disclosed or expressly referred to in the patent. This is quite obvious from a mere reading of the claims and disclaimers. The Court in its Opinion stated that it agreed with the views expressed by the learned trial Judge upon the subject of the disclaimers. We therefore refer to the Opinion of the trial court, 54 F. (2d) 691, for the facts, which are

there set forth at length. With respect to one of the disclaimers it appears that the apparatus claimed in the patent was concededly inoperative, and that the effect of the disclaimer was to add to the invention operative features which were not disclosed at all in the patent, which were not only not thought of by the patentee but were contrary to the instruction of his patent. With respect to the other disclaimer the same situation appeared, because the original claim was directed entirely to a trailer—not a tractor—and contained no reference to a tractor but the disclaimer introduced the tractor—a different machine—making a new claim out of the original—a claim for the combination of a trailer and tractor.

There is a general statement in the opinion of the Circuit Court of Appeals in the *Trailer* case which if read without regard to the facts in that case, may perhaps give the appearance of conflict with the decision in the case at bar. But every opinion must be read with regard to the facts of the case and the question actually decided. *Cohens* v. *Virginia,* 6 Wheat. 264, 399; *Weaver* v. *Palmer Bros.,* 270 U. S. 402, 414; *Tyson & Bros.* v. *Banton,* 273 U. S. 418, 432; *Sterling* v. *Constantin,* 287 U. S. 378, 400; *Home Bldg. & L. Assoc.* v. *Blaisdell,* 290 U. S. 398, 434.

When the opinion in the *Trailer* case is thus read no conflict appears. Upon the facts of that case invalidity of the disclaimer was perfectly apparent under the rule in *Hailes* v. *Albany Stove Co.,* 123 U. S. 582. General statements in an opinion going beyond the facts in the case do not raise conflicts of decisions because decision in each case is necessarily confined by the facts presented and cannot be broadened by generalities thrown out in the opinion.

THERE IS NO UNCERTAINTY IN THE RULE OF LAW TO BE APPLIED UNDER R. S. 4887 IN DETERMINING WHETHER THERE HAS BEEN A FORFEITURE OF A PATENT, AND THE RULE OF IDENTITY OF CLAIMS WAS CORRECTLY APPLIED IN THE COURTS BELOW.

The decisions of this Court in *Leeds & Catlin Co.* v. *Victor Talking Machine Co.*, 213 U. S. 301, and *Fireball Gas Tank & Ill. Co.* v. *Commercial Acetylene Co.*, 239 U. S. 156, establish the rule that forfeiture under R. S., 4887, depends upon the identity of invention claimed in the two patents; that claims are independent inventions; that a process claim is a distinct invention from an apparatus claim, and that although certain elements may be common to the claims of both patents this does not establish their identity. Applying these rules as established by the applicable decisions of this Court the trial court found that there were several features in the claims at issue not disclosed in the German patent; that the German patent was inoperative; that there was no substantial identity of invention claimed in the foreign patent to that claimed in the claims at issue, and that accordingly there was no forfeiture under the statute (Vol. II, pp. 1033; 1075; 1088). See also the Circuit Court of Appeals' findings (Vol. II, pp. 1168-1172). Of course the German patent in this case was not prior art, since the two patents were co-pending (Vol. II, p. 1089). In view of the decisions in the *Victor Talking Machine case, supra,* and the *Fire Ball Gas Tank case, supra,* the earlier decision in *Siemens* v. *Sellers,* 123 U. S. 276, cannot be read in qualification of the rules so clearly laid down in the later decisions of this Court which expressly limit the decision in *Siemens* v. *Sellers* to the facts that were under consideration in that case which disclosed identity of invention. Furthermore the question of identity is largely one of fact. *Victor Talking Machine case,* supra (at pp. 322-323).

CONCLUSION.

The decision below is correct. It is in accord with the applicable decisions of this Court and is not in conflict with the decision of any other Circuit Court of Appeals. The questions presented involve the application of well settled rules of law to facts peculiar to this case, are not of general importance and are not worthy of review in this Court.

Respectfully submitted,

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APPENDIX.

CLAIMS RELIED ON, AS GRANTED, WITH DISCLAIMER APPLIED.

(Under ¶a of the disclaimer [Vol. III, p. 227], the specification and claims are directed only to combinations and methods as embodied respectively in apparatus wherein and methods whereby sound is translated by light to or from a film strip moving uniformly past said light.)

Claim 5.

In phonographic apparatus in which the sound record is formed on an elongated ribbon of inconsiderable mass, having feeding perforations therein, the combination of means for supporting and progressing the record ribbon from one point to another point and past an intermediate point at which the record is made on the ribbon in recording or from which the record is taken from the ribbon in reproducing, including a toothed cylinder over a portion of which the ribbon passes adjacent to said intermediate point, the teeth of said cylinder engaging the perforations of the ribbon, a fly-wheel associated with said cylinder, and means for rotating said cylinder, under control of said fly-wheel at uniform speed.

Claim 7.

In phonographic apparatus in which the sound record is formed on an elongated carrier of inconsiderable mass, the combination of means for supporting and progressing the elongated carrier from one point to another point, and past an intermediate point at which the record is made on the carrier in recording or from which the record is taken from the carrier in reproducing, including a cylinder over a portion of the periphery of which the

carrier passes adjacent to said intermediate point, a fly-wheel, a shaft on which said cylinder and fly-wheel are both secured, a driving member coaxial with said shaft, a resilient connection between said driving member and fly-wheel, and stop means for limiting the amount of yielding of said resilient connection.

Claim 9.

The method of translating sound or similar vibrations to or from a film record by the use of light varied in accordance with the sound, which comprises flexing the film arcuately longitudinally at the point of translation and rapidly and uniformly moving the film in a circumferential direction past said point.

—wherein the uniformity of movement of the film past the translation point is effected by subjecting the portion of the film passing said point to the control of the inertia of a rotating weighty mass (see disclaimer ¶b).

Claim 13.

An apparatus for reproducing speech, music or the like sounds from vibrations recorded on a film, by the use of a line of light varied in accordance with the sound, comprising a photoelectric cell, means for imparting to the film a rapid and uniform motion longitudinally of the film past said cell, a source of light projection for providing said light, and an objective lens in the path of said light and spaced from the film for directing said light as a converging narrow line impinging on the film at a point in the region of the focal point of said lens, said light passing through the film and on to said cell, the space between said lens and the film being free of obstructions to said light.

—wherein a flywheel is operatively connected with the film through means which imparts uniformity of motion of the flywheel to the film (see disclaimer ¶c).

Claim 17.

In phonographic apparatus in which the sound record is formed on an elongated carrier of inconsiderable mass, the combination of means for supporting and progressing the elongated carrier from one point to another point, and past an intermediate point at which the record is made on the carrier in recording or from which the record is taken from the carrier in reproducing, including a cylinder over a portion of the periphery of which the carrier passes adjacent to said intermediate point, a fly wheel operatively associated with said cylinder, said carrier progressing means operating to advance the carrier past said intermediate point at uniform speed under the control of said fly wheel.

—wherein a sprocket engaging the carrier forms a part of the carrier progressing means and a substantial portion of the periphery of the cylinder is in contact with the carrier in its travel from the intermediate point to said sprocket (see disclaimer ¶d).

Claim 18.

The method of translating sound or similar vibrations to or from a film record by the use of light varied in accordance with the sound comprising rapidly advancing the film past the point of translation, and subjecting the motion of the film in passing said point, to the control of inertia means to effectively eliminate irregularities in the movement of the film.

—wherein the inertia control is effected by passing the film over a rotating member and so applying inertia thereto as to eliminate substantially all irregularities in its rotation (see disclaimer ¶e).

Claim 19.

The method according to claim 18, and in which the film is yieldingly pressed into contact with a supporting area immediately adjacent the point of translation, such pressure cooperating with the inertia control in the elimination of irregularities in the film motion.

—wherein the inertia control is effected by passing the film over a rotating member and so applying inertia thereto as to eliminate substantially all irregularities in its rotation (see disclaimer ¶e).